

REMARKS

I. Status of the Claims

Applicant submits this Amendment in reply to the Office Action dated July 28, 2009. Claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 36, 37, 40, 41, 44, 48, 49, 51, 54-57, 61, and 72-94 are the pending, non-withdrawn claims, with claims 1, 40, 72, 84, and 91 being independent. By this Amendment, Applicant has amended claims 1, 2, 40, 44, 48, 49, 52, 56, 57, 84, 86, 88, 91, and 92; canceled claims 54 and 55, without prejudice or disclaimer; and added new claims 95-100. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended and new claims, and no new matter has been entered.

As an initial matter, Applicant would like to thank Examiner Nguyen for the courtesy of the telephone interview conducted with the Applicant's representatives on September 25, 2009. In the interview, the Examiner's interpretation of the applied references and the claims, particularly independent claims 1, 40, 72, 84, and 91, were discussed. Proposed amendments to claims 1, 40, 84, and 91 were also discussed. The amendments and remarks made herein are consistent with the discussion made during the interview.

In the Office Action, the specification is objected to for allegedly failing to provide antecedent basis for the claim 2 recitation, "one half of a cross-section of the elongate member." (Office Action at p. 3.) Moreover, claims 7, 8, 16, 17, 48, and 49 are objected to for allegedly "failing to limit the subject matter of a previous claim." Id. Claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 37, 40, 41, 44, 48, 49, 51, 54-57, and 72-94 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent

No. 5,344,011 to DiBernardo et al. ("DiBernardo"). In addition, claims 36 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over DiBernardo in view of U.S. Patent No. 5,702,080 to Whittier et al. ("Whittier"). Applicant respectfully traverses for at least the following reasons.

II. Objections

The Office Action objects to the specification for allegedly failing to provide antecedent basis for the recitation "one half of a cross-section of the elongate member" of claim 2. Id. As disclosed in ¶ 0031 of the U.S. Publication, the at least one groove is configured to retain "at least one-half the diameter" of the elongate member. Therefore, without necessarily agreeing with the claim objection, Applicant has amended claim 2 to recite, "one-half the diameter." The specification therefore provides sufficient antecedent basis for claim 2.

Claims 7, 8, 16, 17, 48, and 49 are objected to for allegedly "failing to further limit the subject matter of a previous claim." (Office Action at p. 3.) Applicant disagrees. Claim 7 recites that "the at least one groove is defined by the proximal portion," and claim 48 recites that "the groove is defined by the proximal portion." Claim 8 recites that "the at least one groove is defined by the distal portion," and claim 49 recites that "the groove is defined by the distal portion." Each of these claims further limits the claim from which it depends by specifying to which portion ("proximal" or "distal") of the handle "the at least one groove" (claims 7 and 8) or "the groove" (claims 48 and 49) is defined. Claims 16 and 17 further limit claim 1 at least by specifying that "at least one groove" includes "at least two grooves." Accordingly, each of claims 7, 8, 16, 17, 48, and 49 further limits the subject matter of a previous claim.

III. The Independent Claims

Applicant respectfully traverses the Section 102 rejection of independent claims 1, 40, 72, 84, and 91. For anticipation, each and every feature recited in a claim must be found in one item of prior art, either expressly or inherently, and arranged in the item of prior art in the same way as it is claimed. See MPEP 2131 ("The elements must be arranged as required by the claim, ... In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."). That is, the identical invention must be shown in as complete detail as is contained in the claim. See, e.g., Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) ("To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.") Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

A. Claim 1

Independent claim 1 recites, among other things, a medical device including a handle, an end effector assembly, and an elongate, flexible member connecting the handle to the end effector assembly. The handle includes a spool portion including at least one groove accommodating a portion of the end effector assembly, "the spool portion being configured to actuate the end effector assembly when the end effector assembly is in a body of a patient and the spool portion is outside the body of the patient."

In this case, no embodiment of DiBernardo discloses or suggests a medical device including a spool "configured to actuate the end effector assembly when the end effector assembly is in a body of a patient and the spool portion is outside the body of

the patient.” In rejecting claim 1, the Office Action relies on Figs. 1 and 3 of DiBernardo and appears to characterize housing 10 as allegedly corresponding to the claimed spool and balloon 27 as allegedly corresponding to the claimed end effector assembly.

(Office Action at pp. 4-5.) Even assuming the Office Action’s characterizations of DiBernardo are correct, which Applicant does not concede, DiBernardo fails to disclose or suggest at least that housing 10 is “configured to actuate” balloon 27 when balloon 27 “is in a body of a patient and” housing 10 “is outside the body.”

DiBernardo therefore does not anticipate claim 1, and Applicant requests withdrawal of the Section 102 rejection of this claim based on DiBernardo.

B. Claims 40, 72, 84, and 91

Claims 40, 72, 84, and 91 each recites, among other things, a medical device including a handle, an end effector assembly, an elongate, flexible member connecting the handle to the end effector assembly, and a groove defined by the handle, wherein “a plurality of loops of the elongate member is disposed” in the groove (claim 40), wherein the groove “houses each of the loops” (claim 72), wherein the groove “accommodates a plurality of loops of the elongate member and a portion of the end effector assembly” (claim 84), or wherein the groove “houses the plurality of loops” (claim 91).

DiBernardo fails to disclose or suggest a medical device as defined in claims 40, 72, 84, and 91. For example, DiBernardo fails to teach or suggest at least a groove and an elongate member forming loops, wherein the “plurality of loops of the elongate member is disposed” in the groove (claim 40), wherein the groove “houses each of the loops” (claim 72), wherein the groove accommodates the “plurality of loops of the elongate member and a portion of the end effector assembly” (claim 84), or wherein the groove “houses the plurality of loops” (claim 91). The Office Action relies on Figs. 1-3 of

DiBernardo and appears to characterize sheath 14 as allegedly corresponding to the claimed elongate member and an arcuate passageway 13 as allegedly corresponding to the claimed groove. (Office Action at pp. 4-5.) Even assuming the Office Action's characterizations of DiBernardo are correct, which Applicant does not concede, DiBernardo fails to disclose or suggest the features of claims 40, 72, 84, and 91. One arcuate passageway 13 does not house or accommodate multiple loops of sheath 14 (nor are loops of sheath 14 "disposed" in an arcuate passageway 13).

DiBernardo therefore does not anticipate claims 40, 72, 84, and 91, and Applicant respectfully requests withdrawal of the Section 102 rejection of these claims based on DiBernardo.

IV. **The Dependent Claims**

Claims 2, 3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 37, 41, 44, 48, 49, 51, 56, 57, 72-83, 85-90, 92-100 depend either directly or indirectly from either independent claim 1, 40, 72, 84, or 91 and are allowable over DiBernardo at least due their dependence.

In rejecting dependent claims 36 and 61, the Examiner concedes that DiBernardo fails to disclose that "the end effector assembly is a forceps." (Office Action at p. 7.) The Office Action the relies on the teachings of Whittier for its alleged teaching of "forceps jaws." Id. Even assuming that the Office Action's characterizations are correct, which Applicant does not concede, Whittier fails to cure the deficiencies of DiBernardo discussed above. It is therefore requested that the rejection of dependent claims 36 and 61 be withdrawn, and that dependent claims 36 and 61 be allowed.

In addition, the dependent claims recite unique combinations that are neither taught nor suggested by the cited references, and therefore also are separately

patentable for these recitations. For example, the cited references fail to teach or suggest that "at least one of the plurality of grooves and at least one of the another plurality of grooves are circumferentially aligned with each other and are discontinuous with the central portion," as disclosed in new claims 97-99.

V. Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.


In view of the foregoing amendments and remarks, this claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicant therefore respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By  _____
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